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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Applicant : William J. Schmidt
Serial No. : 09/385,405
Filed : August 30, 1999
For : METHOD FOR THE PURIFICATION AND
RECOVERY OF WASTE GELATIN
Examiner : Robert J. Popovics
Art Unit : 1724
Attorney Docket No. : 671.1.002 CIP-3

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING DEPOSITED WITH THE UNITED STATES POSTAL SERVICE AS FIRST CLASS MAIL IN AN ENVELOPE ADDRESSED TO: COMMISSIONER FOR PATENTS, P.O. BOX 1450, ALEXANDRIA, VIRGINIA 22313-1450

ON May 14, 2003
NAME Jill S. Garretson

SIGNATURE

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

May 14, 2003

RESPONSE TO OFFICE ACTION

Dear Sir:

This is in response to the Office Action of March 13, 2003.

At the outset, it should be noted that Applicant has filed a Notice of Appeal and Appeal Brief in response to the final Office Action of May 21, 2002. It was Applicant's position then, as it is now, to take this matter before the Board of Appeals in view of the untenable position taken by the Examiner not only with the respect to

ARK:jsg051403\6711002CIP-3.RES

the claimed technology but the characterization of the Schmidt et al. prior art reference.

Instead of filing a Reply Brief, the Examiner has now come back with an Office Action stating that new grounds of rejection have necessitated the reopening of prosecution. This is a further indication of the untenable position adopted by the Examiner in this case.

The first seven pages of the Office Action set forth word for word the Section 112, 102 and 103 rejections set forth in the final Office Action of May 21, 2002. Not one reference is made to Applicant's Reply Brief and the complete analysis of the claimed invention, the prior art and the patentable features of the claimed invention provided therein. The only difference resides in paragraph 18 in which claims 74 and 82, instead of being rejected on Schmidt et al. alone, now cite Dutre et al., a reference that was applied against the subject matter of the present claims in an Office Action of June 2, 2000 and thereafter removed as a reference. The only reason that Dutre et al. was cited is to show the existence of tangential flow filters which was long ago acknowledged by Applicant.

Thus, insofar as the rejection based on Schmidt et al., the Examiner has done nothing to advance prosecution of this case by the issuance of a new Office Action and certainly has not raised a new ground of rejection necessitating the reopening of prosecution.

Paragraphs 19 and 20 of the Office Action now reject the claims of the application for obviousness-type double patenting under U.S. Patent No. 6,361,802. The Examiner has once again shown a complete lack of understanding of the presently claimed invention and now has mischaracterized the '802 Patent.

Claim 71 of the present application requires in step (c) treating the solvent based layer with a process which removes the first component from the solvent based layer. The first component is one which cannot effectively be separated from the initial liquid formed when a solvent is added to the waste gelatin material. Once again, the present invention is directed to the treatment of the solvent based layer to remove impurities therein which stay with the solvent based layer when the separation step has been completed.

The '802 Patent is concerned with the non-solvent based layer (column 4, beginning at line 48). Nowhere does the Examiner present any basis upon which the '802 Patent and the presently claimed invention relate to the same invention. There is no statement as to where in the '802 disclosure that the solvent based layer is treated in a particular manner to remove first components as defined in the present claims. This is because the process of the '802 Patent is solely concerned with recovering the non-solvent fills from the non-solvent based layer and is not concerned with the solvent based layer. The '802 Patent, in the only statement made about the solvent based layer, states at column 4, lines 41-47 that "the lower aqueous phase is separated using a sight glass, and is conveyed to an apparatus where it may be further processed to recycle the gelatin, plasticizer and if applicable

ARK:jsg051403\6711002CIP-3.RES

dyes and other water soluble components, or are discarded". There is no teaching or suggestion of how to treat the solvent based layer in the particular manner taught in the present application and claimed herein. The '802 Patent is clearly directed to a different invention.

Finally, Applicant takes issue with the offensive remarks made in the section entitled "Response To Arguments". In particular, the Examiner appears to believe that the present application used the Schmidt et al. patent as a blueprint to draft the present application and that in and of itself is grounds for rejecting the present claims. This is nonsense and has no basis under the law.

Secondly, the Examiner deems the arguments presented in the Brief on Appeal to be incomprehensible. So be it. Let the Board of Appeals decide whether the arguments are incomprehensible and don't pretend to present new grounds of rejection in what appears to be an effort to delay a review of this case by an objective standard.


Paragraph 1 of the Office Action states that Applicant can file a reply or request reinstatement of the Appeal.

The Examiner is to consider this response as a reply under 37 CFR 1.111. If the Examiner maintains any rejections, then reinstatement of this Appeal will be requested.

ARK:jsg051403\6711002CIP-3.RES

It is believed that no fee is due in connection with this matter. However, if any fee is due, it should be charged to Deposit Account No. 23-0510.

Respectfully submitted,


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